

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

Singhal, et al.

Serial No.: 10/809,223

Filed: 3/25/2004

Examiner: Holder

Group Art Unit: 2621

Confirmation No. 6554

Electronically Filed  
September 2, 2008

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sirs:

This correspondence is filed in response to the office action of May 2, 2008.

REMARKS

Claims 1, 2, 3, 9-14, 20, and 21 are presently pending. Claims 5-8, and 15-19 are cancelled without prejudice. Assignee respectfully requests pre-appeal brief review of the rejections.

Claims 1, 9, and 20 were rejected under 35 U.S.C. 103(a) as being obvious from Ritchey. Claim 9 recites, among other limitations, "wherein audio decoding comprises MPEG 1 level 3 decoding processes".

Examiner has indicated that "Ritchey teaches the use encoding and decoding of MPEG video it would have been obvious at the time the invention was made that MPEG standards applies to both video of and audio processed with the device of Ritchey. It is suggested in Ritchey specification that several formats are applicable such 'NTSC, PAL, SECAM, IDTV, HDTV, or the like' is processed within the device which inherently supports MPEG 1 level 3 or the like". Office Action at 2.

Assignee respectfully traverses the rejection. Even if it is true that "MPEG standards" are applicable to "both video ... and audio processed with the device of Ritchey", it does not follow that Ritchey teaches "audio decoding comprises MPEG 1, Level 3 decoding processes". "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Even if it is true that "MPEG standards" are applicable to "both video ... and audio processed with the device of Ritchey",

there is no teaching in Ritchey that MPEG standards must be used.

Additionally, Assignee respectfully submits that formats such as "NTSC, PAL, SECAM, IDTV, HDTV, or the like" do not inherently teach MPEG 1 level 3 or the like. NTSC, PAL, SECAM, IDTV, and HDTV are *video display* standards, while MPEG 1 level 3 is an *audio compression* standard.

Thus, for at least the foregoing reasons, Assignee respectfully requests that the rejections to claims 1, 9, and 20 be withdrawn.

For at least the foregoing reasons, each of the pending claims are in a condition for allowance and such a notice is respectfully requested. Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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September 2, 2008

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>15465US01</b>	
I hereby certify that this correspondence is being electronically filed with United States Patent and Trademark Office		Application Number <b>10/809,223</b>	Filed March 25, 2004
on <u>September 2, 2008</u>		First Named Inventor Singhal	
Signature <u>/Mirut P. Dalal/</u>		Art Unit 2621	Examiner Holder, Anner N.
Typed or printed Name <u>Mirut P. Dalal</u>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p>           <p>This request is being filed with a notice of appeal.</p>           <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>44,052</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>                    </u>		<u>/Mirut P. Dalal/</u> Signature  <u>Mirut P. Dalal</u> Typed or printed name  <u>(312) 775-8063</u> telephone number  <u>September 2, 2008</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of <u>      </u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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